

### **REMARKS**

Claims 1-12 are pending. Claim 1 was rejected under 35 U.S.C. § 112 as being indefinite for failing to point out and distinctly claim the subject matter which applicant regards as the invention. Claims 1, 2, and 5-11 were rejected under 35 U.S.C. § 102(b) as being anticipated by Osypka (US 4,550,737). Claims 3 and 4 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Osypka. Claim 12 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Osypka when viewed in combination with Audoglio (US 6,556,874).

Examiner also indicated that Applicant's papers filed under 35 U.S.C. § 119(a) – (d) failed to comply with the requirements of 37 CFR 1.63(c) due to an inadvertent typographical error regarding one of the dates.

#### **I. Formalities**

Applicant thanks the Examiner for pointing out the typographical error in its papers filed under 35 U.S.C. § 119(a) – (d). To correct the error, Applicant now submits, along with the Amendment and Response papers, a new application data sheet that reflects the correct date of June 26, 2002.

#### **II. 35 U.S.C. § 112 Rejection**

Claim 1 has been amended to clearly show that the first diameter applies to the sheath, as correctly understood and indicated by the Examiner. For this reason, Applicant now respectfully asks that the Examiner withdraw the grounds for this rejection.

#### **III. 35 U.S.C. § 102(b) Rejection**

Claims 1, 2, and 5-11 were rejected under 35 U.S.C. § 102(b) as being anticipated by Osypka (US 4,550,737). Applicant respectfully traverses the grounds for this rejection. Claim 1

has been amended to include the limitation found in claim 2, specifically requiring that the "overall circular contour further comprises an eccentric contour relative to the first axis of the cylindrical body." Applicant, respectfully, believes that the Examiner may have misunderstood the meaning of this claim limitation. Contrary to the Examiner's assertion, the "eccentric contour" does not refer to the varying height or angle of the screw threads that the Examiner cites to in Osypka at Figure 2. In the present invention, the "eccentric contour" relates to how the threads are offset relative to the axis of the sheath – one embodiment of which is shown in Figure 3.

“[A] claim is anticipated if each and every limitation is found either expressly or inherently in a single prior art reference.” *Celeritas Techs., Ltd. v. Rockwell Int’l. Corp.*, 150 F.3d 1354, 1361, 47 U.S.P.Q.2d 1516, 1522 (Fed. Cir. 1998). The standard for lack of novelty, that is, for “anticipation,” is one of strict identity. *Trintec Indus., Inc. v. Top-U.S.A. Corp.*, 295 F.3d 1292, 1296, 63 U.S.P.Q.2d 1597, 1600 (Fed. Cir. 2002). The probe head disclosed in Osypka does not disclose or suggest an eccentric contour as claimed in the present invention. Indeed, although the radius of the threads may vary in the Osypka probe head, the contour is not "eccentric" relative to the axis of the cylindrical body of the probe because there is no offset of the threads relative to the axis, as disclosed in the present invention. As stated above, without either an express or inherent disclosure of this claimed functionality Osypka cannot be anticipating prior art under 35 U.S.C. § 102. For this reason, the Applicant respectfully asks that the Examiner withdraw this rejection of claim 1, as amended, and dependent claims 5-11.

#### **IV 35 U.S.C. § 103(a) Rejections**

Claims 3 and 4 were rejected under 35 U.S.C. § 103(a) as being unpatentable over

Osyпка and claim 12 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Osypka when viewed in combination with Audoglio (US 6,556,874). Applicant respectfully traverses the grounds for this rejection in view of the above amendments to the claims and the following remarks.

To establish a *Prima Facie* case of obviousness, there must be: (1) some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine references teachings; (2) a reasonable expectation of success; and (3) prior art references which teach or suggest all of the claim limitations. See *In re Kotzab*, 217 F.3d 1365, 1370 (Fed. Cir. 2000); MPEP § 2143 (8th Ed., Rev. 1). In the present invention, claim 1 as amended requires, among other things, that the "overall circular contour further comprises an eccentric contour relative to the first axis of the cylindrical body." As discussed above, Osypka does not disclose an "eccentric contour" as required by claim 1. Moreover, Audoglio, when viewed either alone or in combination with Osypka, also fails to teach or suggest an "eccentric contour" as claimed in claim 1 of the present invention and thus does not cure the deficiencies of the primary reference. Indeed, the Examiner apparently only relies on Audoglio for the disclosure of a helical retention element with a round profile (see Office Action at p. 6, ¶ 16).

Additionally, neither the Osypka nor Audoglio reference would motivate one to modify either reference to include the "eccentric contour" claimed in the present invention. Instead, both Osypka and Audoglio teach using a standard screw and thread design.

For the foregoing reasons, Applicant believes dependent claims 3, 4, and 12 are now in condition for allowance.

**PATENT**

Attorney Docket No. 8707-2159

167 – Situs Excentre

Customer No.: 34313

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**CONCLUSION**

Reconsideration of this application in view of the foregoing remarks respectfully is requested.

The Examiner is invited to call Applicant's undersigned attorney if doing so would expedite prosecution.

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Respectfully submitted,



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